

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Applicant	: Warren, Jr., et al.	Confirmation No: 5571
Appln. No.	: 10/767,505	Group Art Unit: 2181
Filed	: January 28, 2004	Examiner: Martinez, David E.
Title	: METHOD AND SYSTEM FOR GENERIC DATA TRANSFER INTERFACE	Docket No. STL11661/390-009-USP

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

The Panel is now faced with the task of determining whether the Examiner fundamentally has factually supported a *prima facie* case of anticipation, thereby properly closing the merits of this case. Applicants pray that upon the Panel's objective review of the facts set forth herein it will reach the conclusion that this case is not in condition for appeal. Rather, there are unresolved issues in this case that are not bona fide matters for appeal, but which must be resolved before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A *PRIMA FACIE* CASE OF ANTICIPATION BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCE EXPRESSLY OR INHERENTLY DESCRIBES ALL OF THE RECITED FEATURES OF INDEPENDENT CLAIMS 1, 7, AND 15

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See, e.g.*, MPEP § 2131. Applicants respectfully submit that, in the instant application, the Office has failed to provide evidence to support the assertion that U.S. Patent Application Publication No. 2002/0169960 by Iguchi, et al. ("Iguchi") fails to expressly or inherently describe all of the recited features of independent claims 1, 7, and 15. Thus, the Office has not established a *prima facie* case of anticipation.

Independent claim 1 recites, *inter alia*, that the host interface will communicate over a data bus with the media controller, and that a connection for address-less transfer is established between the indicated virtual channel of the host interface and a corresponding virtual channel of the media controller. The interface 144 comprises the host interface and the media controller. Thus, the connection established between the host interface and the media controller is within Interface 144 of the storage device, shown in Fig. 2 of the present application (below). This connection is illustrated in FIG. 3 of the present application (below). Independent claims 7 and 15 recite similar features.

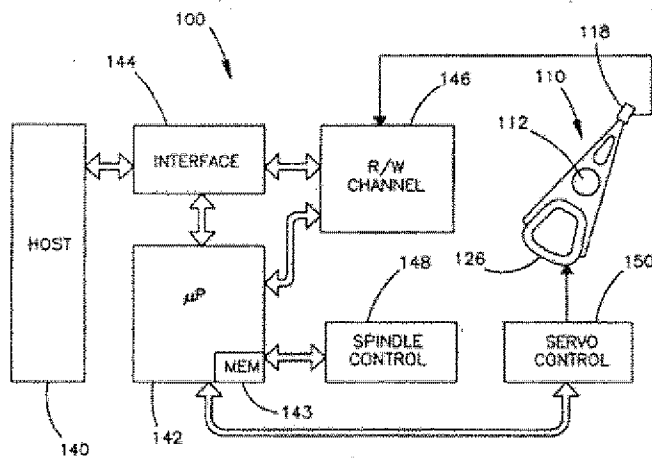


FIG. 2

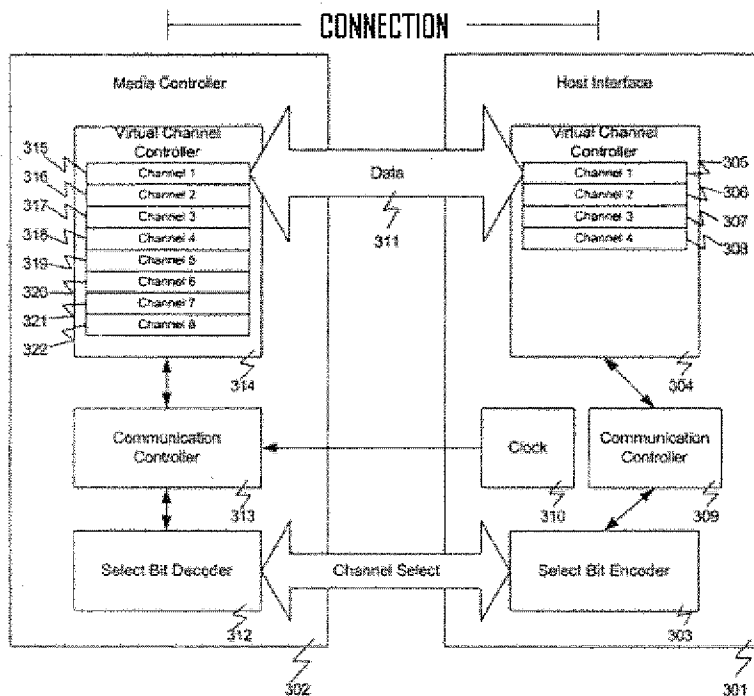


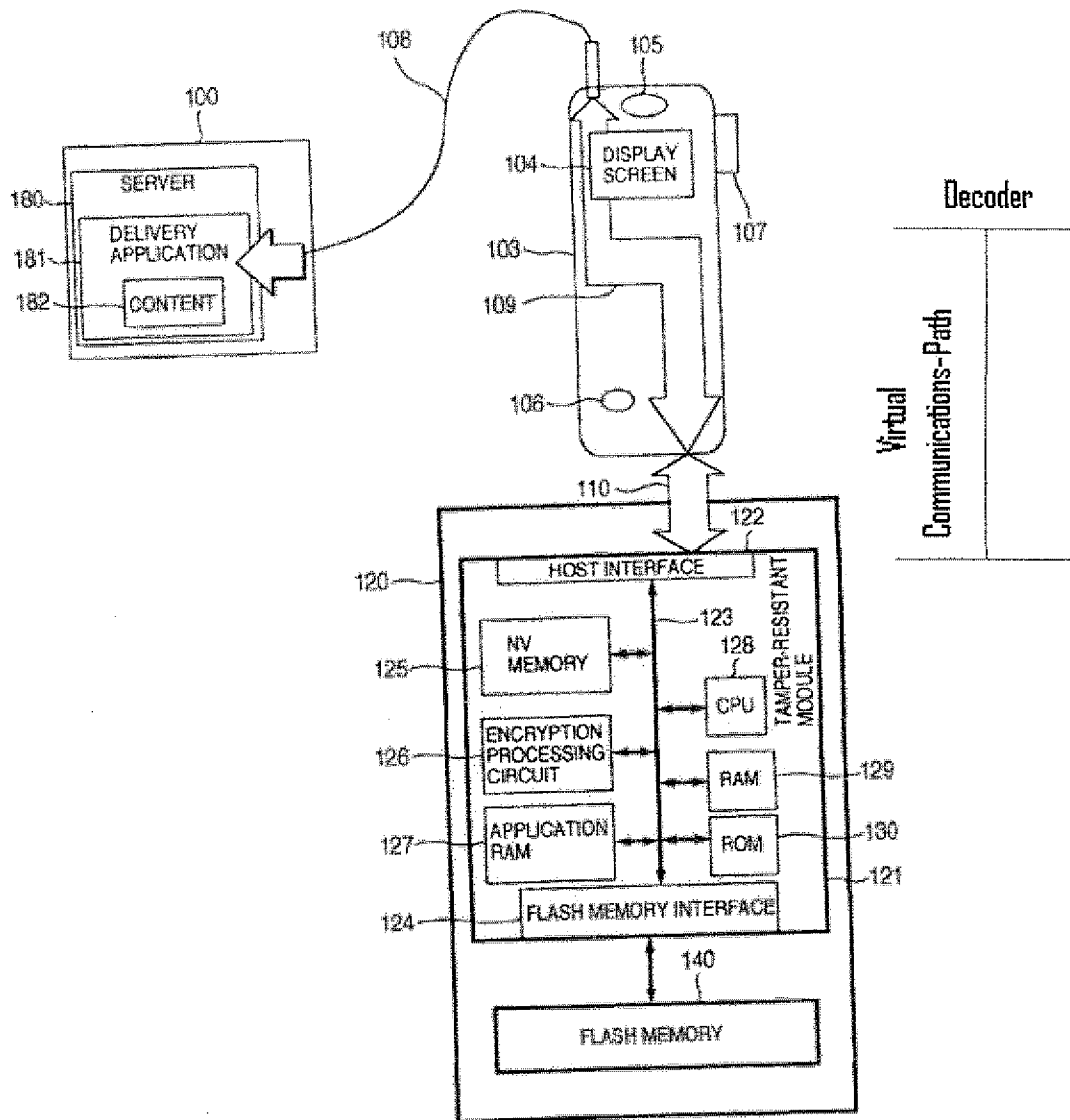
FIG. 3

In the Advisory Action mailed March 17, 2008, the Office states that “As per Applicant own admission, ‘Iguchi creates a virtual communications-path between the decoder circuit in the mobile terminal (the host 103) and the storage device 120’, and this it being a connection between a host (the mobile terminal 103) and a media controller (storage device 120 – storage being made of media). Applicants, however, respectfully disagree and submit that the storage device 120 (specifically host interface 122) is not a media controller.

Applicants note that the interpretation of any aspect of storage device 120 of Iguchi as a “media controller”, as in the Advisory Action mailed March 17, 2008, is inconsistent with the Office’s statement at page 3 of the Final Office Action mailed December 12, 2007. Specifically, at page 3 of the Final Office Action, the Office alleges that Iguchi teaches a media controller and cites element 103 (the mobile terminal), as shown in FIG. 17, in support of this position. The Office states that the media controller is “inside element 103”. This is inconsistent with the Office’s assertion in the Advisory Action that the storage device 120 is a media controller because “storage is made of media.”

Iguchi explicitly establishes a “virtual communications-path between the decoder circuit 206 and the storage device 120.” Iguchi at [0119]. The decoder circuit 206 is located within mobile terminal 103, Iguchi at Fig. 3. Thus, as shown below in FIG. 2, Iguchi creates a virtual communications-path between the decoder circuit in the mobile terminal (the host) 103 and the storage device 120.

FIG.2



Specifically, host interface 122 of the storage device 120 is used for transmitting/receiving an access command 1120 between the storage device 120 and an external appliance connected to the storage device 120, such as mobile terminal 103. Iguchi at [0041]. Thus, any connection established between the mobile terminal 103 and the storage device 120 is established between the decoder circuit 206 and the host interface 112. Iguchi fails to disclose or suggest that the host interface 112 serves as a media controller. Thus, Iguchi fails to disclose or suggest that any connection is established between the mobile terminal 103 and a media controller.

Independent claims 1, 7, and 15 each recite a connection between a host interface and a media controller. Iguchi, in contrast, explicitly teaches a virtual communications-path between the decoder of the mobile terminal and the host interface of the storage device. Accordingly, Applicants respectfully

submit that Iguchi fails to disclose all of the features of independent claims 1, 7, and 15, and those claims depending directly or indirectly therefrom. Reconsideration and allowance of the claims is respectfully requested.

Before a closing of the merits, Applicants are entitled to an evidentiary showing that the cited reference discloses all the recited features of the rejected claims. Applicants have argued that Iguchi fails in this regard, and the Examiner has failed to provide any evidence that the cited reference discloses all of the recited features of the independent claims. This leads to an unresolved legal issue that the Applicants should not be forced to go forward with on appeal in the absence of a *prima facie* case of anticipation.

Respectfully submitted,

Date: April 17, 2008

/Allison Olenginski/
Allison Olenginski, Reg. No. 55,509
Attorney for Applicant
USPTO Customer No. 64776

HENSLEY KIM & HOLZER, LLC
1660 Lincoln Street, Suite 3000
Denver, Colorado 80264
Tel: 720-377-0770
Fax: 720-377-0777